

## REMARKS

Upon entry of the present amendment, the claims in the application are amended claims 1 and 11.

With regard to amended claims 1 and 11, attention is respectfully directed to the following portions of applicant's patent specification.

Page 4, lines 2-5 of applicant's specification states:

"It is a primary object of the present invention to provide a novel and unique method of advertising and a container as described hereinabove wherein there is utilized the otherwise 'blank' spaces on the fronts, sides, backs, etc. of corrugated or chipboard shipping/packaging cartons". (Underscoring added for emphasis).

Attention is also directed to applicant's specification page 5, lines 9-11, which states:

"The container 1 may take any conceivable size and/or shape, even though the particular shape illustrated in the drawings is that of a rectangular parallelepiped". (Underscoring added for emphasis).

Attention is also respectfully directed to applicant's specification page 6, lines 12-14, which states:

"In accordance with the present invention, this novel and unique method of advertising utilizes otherwise 'blank' space on the front, back, sides, top, and/or bottom of, for example, corrugated or chipboard shipping/packaging cartons 1." (Underscoring added for emphasis).

Attention is also directed to applicant's specification page 7 lines 9-11, which states:

"In accordance with the present invention, the advertisement would be printed on areas of shipping/packaging cartons or other types of containers 1 which would otherwise be blank or void of any printed detail." (Underscoring added for emphasis).

Attention is also respectfully directed to applicant's specification, page 7, lines 17-20 which states:

“The advertisements could be printed in four color or black and white directly on the corrugated box surface, or as a printed laminate for corrugated surfaces for higher end graphic applications”. (Underscoring added for emphasis).

#### **Claim Rejections - 35 USC § 112**

The previous claims 1 and 11 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1 and 11 have been amended to overcome the alleged lack of enablement rejection.

#### **Claim Rejections - 35 USC § 103**

The last OA rejects previous claims 1 and 11 under 35 USC 103(a) as being unpatentable over Bichaylo et al. US 3,498,815 in view of the practice of placing advertisements for missing children on milk cartons (hereinafter missing-child).

Applicant respectfully traverses this 35 USC 103(a) rejection of the previous claims 1 and 11, especially in view of the claims as now amended.

The last OA states that regarding the method of claim 1, Bichaylo is exemplary of a standard milk carton. (Underscoring added for emphasis).

Applicant respectfully traverses this.

Applicant respectfully submits that Bichaylo is not exemplary of a standard milk carton.

In contrast, applicant respectfully submits that Bichaylo relates to a method for placing invisible marks on a paper or plastic container or bag for merchandising products. (Underscoring added for emphasis).

Furthermore, the Bichaylo method for placing invisible marks, comprises a first printing operation using an alkaline-sensitive colored ink to cover an area of the container surface followed by a second printing operation using an alkaline-resistant transparent ink to form a desired invisible mark. (Underscoring added for emphasis).

In addition, according to Bichaylo, upon subsequent application of an alkaline solution capable of reacting preferentially with the alkaline-sensitive ink, the invisible mark will become visible.

In contrast, a “standard milk carton” is not made with invisible ink, nor does it offer a prize or premium to a consumer who discovers a designated mark, letter, or series of marks and letters on the container.

Applicant further submits that a “standard milk carton” does not include nor require the consumer to treat any portion of the milk carton with an alkali or alkaline solution such as soap, wet cleanser or household ammonia to make any portion of the milk carton or its indicia visible.

In light of the foregoing, applicant respectfully submits that Bichaylo is not exemplary of a “standard milk carton” as alleged in the last OA. Accordingly, applicant respectfully requests that this last OA allegation be reconsidered with a view toward withdrawing same.

The last OA concedes that Bichaylo does not expressly disclose the owner of the carton.

Furthermore, applicant respectfully submits that Bichaylo does not implicitly disclose the owner of the carton.

The last OA states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the milk company also own the carton in order to reduce the number of parties to which profit must be distributed. (Underscoring added for emphasis).

The last OA also states that as such the milk company is considered the first party.

Applicant respectfully traverses this.

The law considers the artisan to have ordinary skill, and knowledge of all the prior art in his or her field. It is respectfully submitted that the law does not consider the artisan to be an expert at making profit, nor to be an expert as to who owns which components of an invention. Consequently, applicant respectfully submits that it would not be obvious to the artisan that the milk company be considered the first party.

With respect to claim 1, the artisan is a person having ordinary skill in the art of methods of advertising. In contrast, the last OA takes the strained position that this artisan would have ordinary skill in the art of having the milk company also own the carton in order to reduce the number of parties to which profit must be distributed. These are two different arts. Consequently, the position taken by the last OA is contrary to the law.

Claim 1 pertains to the art of methods of advertising. Consideration of claim 1 with respect to 35 U.S.C 103 must deal with a person of ordinary skill in the art of methods of advertising. It is respectfully submitted that consideration of claim 1 with respect to 35 USC 103 does not relate to a person skilled in the art of having a milk company also own a carton in order to reduce the number of parties to which profit must be distributed.

Claim 11 pertains to the art of shipping/packaging cartons. It is respectfully submitted that consideration of Claim 11 with respect to 35 USC 103 must deal with a person of ordinary skill in the art of shipping/packaging cartons.

Consideration of claim 11 with respect to 35 USC 103 does not relate to a person skilled in the art of having a milk company also own a carton in order to reduce the number of parties to which profit must be distributed.

Furthermore, claims 1 and 11 have been amended to recite “said second visible advertisement is visibly printed on said predetermined area of said shipping/packaging carton which would otherwise be a blank area or void of any visible details”.

The last OA states that as to the printing on an otherwise blank area, Bichaylo discloses printing on unprinted areas of the blank (see Col. 4, lines 35-40).

In contrast, Bichaylo, col. 4 lines 35-40, states: “For example, in FIG. 1, panels 29-32 and 38-41 of blank 20 may be reverse printed with a colored alkali-sensitive flexographic ink so that the desired design 65 and merchandising copy 66 are formed on the unprinted areas of the blank 20.”

It is clear that Bichaylo is using the term “blank 20” to mean “a single sheet of paper coated on both sides with polyethylene” (Bichaylo, col. 3, lines 16-18), and not to signify something that would “otherwise be a blank area or void of any visible printed details” as required by amended claims 1 and 11.

In addition, amended claims 1 and 11 now require that the carton have the shape of a rectangular parallelepiped , which Bichaylo does not have.

Furthermore, amended claims 1 and 11 now specify that the second visible advertisement is for a product, which is quite different than a service for missing children.

Applicant respectfully submits that an artisan skilled in the art of methods of advertising, or in the art of shipping/packaging cartons, would not look to the method of application and detection of invisible ink on containers of Bichaylo, nor to the art of advertisements for missing children on the side panels of standard milk cartons to make obvious the subject matter as now specified in amended claims 1 and 11.

Furthermore, it is respectfully submitted that applicant’s invention is classified in a very crowded art; and therefore, a small step forward should be regarded as significant and unobvious.

In addition, applicant respectfully submits that if applicant’s invention were in fact obvious, those skilled in the art surely would have implemented it by now. In this connection, it is respectfully pointed out that Bichaylo issued more than 34 years ago. The fact that those skilled in the art have not implemented applicant’s invention, nor have combined the teachings of invisible printing by Bichaylo with the practice of placing advertisements for missing children on milk cartons as suggested by the last OA, indicates that is not obvious.

In addition, applicant’s invention solves a long-felt, long-existing, but unfilled need.

Moreover, it is respectfully submitted that the last OA makes a strained interpretation of the Bichaylo reference and combines it with the practice of placing advertisements for missing children on standard milk cartons, which could only be made by hindsight.

Furthermore, it is respectfully submitted that the last OA does not present a convincing line of reasoning as to why the claimed subject matter as a whole, including the stipulations of the prior art, would have been obvious.

In light of the foregoing, applicant respectfully requests reconsideration of the USC 35 103 rejection based on Bichaylo in view of advertisements for missing children with a view toward withdrawing same, especially in view of the newly-amended claims 1 and 11.

The last OA rejects the previous claim 11 under 35 USC 103 as being unpatentable over MacGuire US 2003/0141214 A1.

The last OA states that MacGuire discloses a shipping/packaging container (2a-2d) with an outer and inner surface, a first advertisement (SOAP) provided by a first party (manufacturer) and a first predetermined area, a second advertisement (2a'-2d') provided by a second party (operating entity) on a second predetermined area, the second party is not affiliated in any way to the first party, and the first party determines the second predetermined area (see for example paragraph [0056]).

The last OA concedes that MacGuire lacks or does not expressly disclose that the second predetermined area would otherwise be blank or that the size of the second advertisement is determined, at least in part, by the shipping/packaging container size.

Applicant agrees with the last OA that MacGuire lacks or does not expressly disclose that the second predetermined area would otherwise be blank or that the size of the second advertisement is determined, at least in part, by the shipping/packaging container size.

Furthermore, applicant respectfully submits that MacGuire does not impliedly disclose or make obvious that the second predetermined area would otherwise be blank or that the size of the second advertisement is determined, at least in part, by the shipping/packaging container size.

In addition, applicant respectfully submits that MacGuire additionally does not disclose or make obvious:

that the second advertisement is for a product; nor

that the second predetermined area of the outer carton surface of the shipping/packaging carton has within the second predetermined area a second visible advertisement for a second product of a second party separate and distinct from the first party, which second product is not contained in or part of the carton; nor

the first and second visible advertisements are both visibly printed directly on the shipping/packaging carton at the same time (in contrast, see MacGuire, paragraph 0056); nor

the second visible advertisement is provided by the second party to the first party without the first party buying the second visible advertisement (in contrast, see MacGuire, paragraph 0056);

all of which features are required and specified in currently amended claim 11.

The last OA rejects previous claim 11 under 35 USC 103(a) as being unpatentable over Kapp U.S. 5,246,161.

The last OA states that Kapp discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). (Underscoring added for emphasis).

The last OA further states that it would have been obvious to one in ordinary skill in the art at the time the invention was made to provide the indicia in the claimed arrangement and content since it would only depend on the intended use of the assembly and the desired information to be displayed. (Underscoring added for emphasis).

The last OA also states that further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). (Underscoring added for emphasis).

The last OA also states that the fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of advertisement does not alter the functional relationship. (Underscoring added for emphasis).

The last OA also states that mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. (Underscoring added for emphasis).

The last OA concludes that thus, there is no novel and unobvious functional relationship between the printed matter, e.g. indicia on panels 12 and 14, and the substrate, e.g. the box, which is required for patentability. (Underscoring added for emphasis).

Applicant respectfully traverses this rejection.

In contrast, applicant respectfully submits that Kapp does not disclose or make obvious:

that the printed matter for the first advertisement is “for a first product of a first party owning said shipping/packaging carton”; nor

that the printed matter for the second advertisement is “for a second product of a second party separate and distinct from said first party, which second product is not contained in or part of said carton”; nor

that the “second visible advertisement is provided by said second party to said first party without said first party buying said second visible advertisement”; nor

that there is even a second party advertising a second product which is not contained in or part of the carton;

all of which features are required by currently amended claim 11.

Furthermore, it is respectfully submitted that *In re Gulack*, 217 USPQ 401, 403 (CAFC1983) states:

“Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole”. (Underscoring added for emphasis).

Attention is also respectfully directed to Footnote 8 of *In re Gulack* which states:

“A ‘printed matter rejection’ under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. A printed matter rejection is based on case law antedating the 1952 patent act, employing a point of novelty approach. *In re Sterling*, 70 F.2d 910, 21 USPQ 519 (CCPA 1934). The 1952 act legislatively revised that approach through its requirement that the claim be viewed as a whole in determining obviousness. *Graham v. John Deer Co.*, 382 U.S. 1, 148 USPQ 459 (1966). The CCPA has considered *all* of the limitations of the claims including the printed matter limitations, in determining whether the invention would have been obvious. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Cavrich*, 451 F.2d 1091, 172 USPQ 121 (CCPA 1971). In *Royka*, 490 F.2d at 985, 180 USPQ at 5583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicted”.

In addition, attention is also respectfully directed to Footnote 9 of *In re Gulack*, which states:

“35 USC § 103 (1976) specifically provides that: ‘A patent may not be obtained \*\*\* if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains \*\*\* (Emphasis supplied.) See *Graham*, 383 U.S. 1, 148 USPQ 459; *Flook*, 437 U.S. at 594 n. 16, 198 USPQ at 199 n. 16 (noting the § 103 requirement of reading claims as a whole and extending that requirement to § 101); *Diamond v Diehr*, 450 U.S. 175, 188, 209 USPQ 1, 9 (1981) (also applying that requirement in a § 101 setting); *Royka*, 490 F.2d at 985, 180 USPQ at 583”.

The last OA states that it has been held that a recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987). (Emphasis supplied.)

The last OA further states that the only structure currently claimed is a container with two forms of indicia in different locations. (Emphasis supplied.)

Applicant respectfully traverses this rejection.

Applicant respectfully directs attention to *In re Miller*, 164 USPQ 46, 48 which states:

“[I]t seems to us that what is significant here is not structural but *functional* relationship \*\*\*.\*\*\* As for the examiner’s characterization of the indicia and legend as ‘unpatentable printed matter,’ we note that the examiner himself recognizes that fact that printed matter, in an article of manufacture claim, *can* be given ‘patentable weight.’ He did so in allowing claims. His characterization of printed matter as ‘unpatentable’ is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter *by itself* is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination.”

Furthermore, applicant respectfully submits that the presence or absence of a specific functional relationship is not dispositive of obviousness. What must be looked at to determine patentability is the existence of differences between the claims and the prior art. There is no suggestion in Kapp of the features specified in applicant’s currently amended claim 11. These features constitute the differences between claim 11 and the prior art which are sufficient to establish patentability.

*In re Gulack*, 217 USPQ 401, 404, states:

“Similarly, in examining Gulack’s invention, we find that a functional relationship does exist between the printed matter and the substrate. A functional relationship of the precise type found by

the CCPA in Miller – to size or to type of substrate, or conveying information about substrate – is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate”.

With regard to all three obviousness rejections stated in the last OA, it is respectfully submitted that the PTO has not met its burden of setting forth a prime facie case of obviousness because there is no explanation in the last OA (other than the hindsight knowledge after having been exposed to the present patent application):

why it would have been obvious to one of ordinary skill in the art of methods of advertising at the time the invention was made to have a milk company also own the carton in order to reduce the number of parties to which profit must be distributed; nor

why it would have been obvious to one of ordinary skill in the art of methods of advertising that the second party is not affiliated (i.e., owned) with the first party, and is therefore separate and distinct; nor

why it would have been obvious to a person skilled in the art of methods of advertising for the first party to allot the area, and determine the size and location for the second advertisement so as not to interfere with the primary graphics of the first advertisement; nor

why it would have been obvious to a person skilled in the art of methods of advertising at the time the invention was made for the second advertisement to be provided by the second party without the first party buying the second advertisement; nor

why it would have been obvious to one of ordinary skill in the art of shipping/packaging cartons at the time the invention was made to place a second advertisement on an area that would otherwise be blank; nor

why it would have been obvious to one of ordinary skill in the art of shipping/packaging cartons at the time the invention was made to provide the indicia in the claimed arrangement and content.

In addition, it is respectfully submitted that up to now those skilled in the art thought or found the problem of unused space on shipping cartons which is solved by the present invention to be insoluble. That is, the present invention converts failure into success. The failures of prior art workers indicate that a solution was not obvious.

Furthermore, the present invention is classified in a very crowded art, and consequently, a small step forward should be regarded as significant.

Additionally, the cited art lacks any suggestion that the references should be modified in a manner required to meet the claims.

In addition, attention is respectfully directed to the concept of lack of implementation. In particular, if the present invention were in fact obvious, because of its advantages, those skilled in the art surely would have implemented it by now. The fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Furthermore, it is respectfully submitted that the present invention solves a long-felt, long-existing, but unresolved, need.

Additionally, teachings of the cited art are in general directed to cartons that advertise only products of the owner or sender of the carton. Therefore, the present invention is contrary to the teachings of the prior art. In particular, the present invention goes against the grain of what the prior art teaches.

Also, it is respectfully submitted that the last OA makes strained interpretations of the cited references that could be made only by hindsight.

Furthermore, it is respectfully submitted that the present invention utilizes a new principle of operation. In particular, applicant has blazed a trail rather than followed one.

Moreover, it is respectfully submitted that applicant's invention solves and is directed to a different problem than that of the cited references, and such different problem is solved by the features recited in the claims. *In re Wright*, 6 USPQ 2d. 1959.

Furthermore, it is respectfully submitted that the last OA has not put forth a convincing line of reasoning as to why the subject matter as a whole as set forth in the currently amended claims 1 and 11, including their differences over the prior art, would have been obvious.

Moreover, it is respectfully submitted that the cited references are from different fields than that of the present invention, and this factor weighs against their use in a rejection. *In re Oetiker*, 24 USPQ 2d 1443.

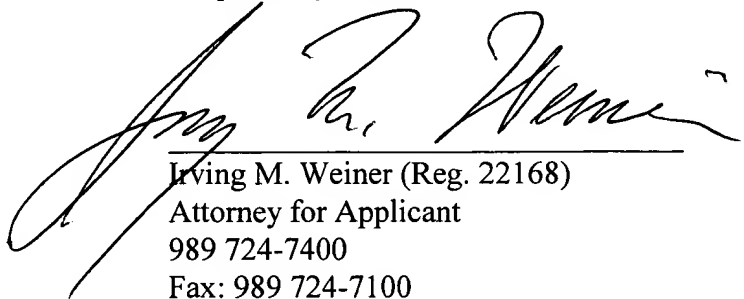
In light of the foregoing, applicant respectfully requests reconsideration of the 35 USC 103(a) rejections with a view toward withdrawing same, especially in view of the newly-amended claims 1 and 11.

It is respectfully submitted that the application is now in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner feels that the application is not now in condition for allowance, it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an effort to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

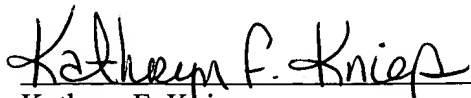


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I hereby certify that the foregoing Amendment-D was sent by first class mail to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 20, 2004.

  
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